

## INTERFERENCE DIGEST

Interference No. 105,486

Paper No.

Name: Robert G. Pergolizzi et al.

Serial No.: 08/479,995

Patent No.

Title: Assay method utilizing polynucleotide sequences

Filed: 06/07/95

Interference with Schneider et al.

### DECISION ON MOTIONS

Administrative Patent Judge, \_\_\_\_\_ Dated, \_\_\_\_\_

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### FINAL DECISION

Board of Patent Appeals and Interferences, \_\_\_\_\_ Dated, \_\_\_\_\_

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Court, \_\_\_\_\_ Dated, \_\_\_\_\_

### REMARKS

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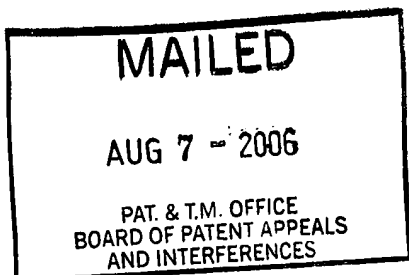
This should be placed in each application or patent involved in interference in addition to the interference letters.



## UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Judge Richard Torczon  
Telephone: 571-272-9797  
Facsimile: 571-273-0042



Applicants: PERGOLIZZI  
Application No.: 08/479,995  
Filed: 06/07/95  
For: Assay method utilizing polynucleotide sequences

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,486.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

/Richard Torczon/  
RICHARD TORCZON  
Administrative Patent Judge

UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

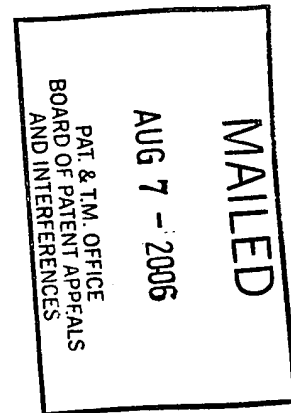
Patent Interference No. 105,486 (RT)  
(From Technology Center 1600)

The Trustees of  
PRINCETON UNIVERSITY  
(4,882,269 and 5,424,188),<sup>1</sup>  
Junior Party,

v.

ENZO BIOCHEM, INC.  
(08/479,995),<sup>2</sup>  
Senior Party.

DECLARATION - Bd.R. 203(b)<sup>3</sup>



By TORCZON, Administrative Patent Judge.

1       A.     Declaration of interference

2           An interference is declared pursuant to 35 U.S.C. 135(a). Details of the application,  
3 patents, count, and claims designated as corresponding to the count appear under headings E  
4 and F of this DECLARATION.

5       B.     Designation to manage

6           Administrative Patent Judge Richard Torczon has been designated to manage the  
7 interference. Bd. R. 104(a).

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<sup>1</sup> Attorney docket ## 4598-031 and 5053-071, respectively.

<sup>2</sup> Attorney docket # ENZ-11(C2)(D1)(C2).

<sup>3</sup> "Bd.R. x" may be used as shorthand for "37 C.F.R. § 41.x". 69 Fed. Reg. 49960, 49961 (12 Aug. 2004).

1 C. Standing order

2 A copy of the Trial Section STANDING ORDER [SO] (Paper 2) accompanies this  
3 DECLARATION. The STANDING ORDER applies to this contested case.

4 D. Conference call to set dates

5 A telephone conference call to set dates for action in this contested case is scheduled for  
6 **2 p.m. (Eastern) on 27 September 2006.** (The Board will initiate the call.)

7 No later than **25 September 2006**, each party shall file and serve (SO ¶¶ 10.1 & 105) a  
8 list of the motions (Bd. R. 120; Bd. R. 204; SO ¶¶ 104.2.1, 120 & 204) the party intends to file.

9 A sample schedule for taking action during the motion phase appears as Form 2 in the  
10 STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference  
11 call and to agree on dates for taking action. A typical motion period lasts approximately eight (8)  
12 months. Counsel should be prepared to justify any request for a shorter or longer period.

13 E. The parties to this interference14 Junior Party

15 Patent: 4,882,269 (06/940,712, filed 11 December 1986)

16 Title: Amplified hybridization assay

17 Inventors: Robert J. Schneider of New York City, New York; and Thomas E. Shenk of  
18 Princeton, New Jersey.

Patent: 5,424,188 (07/963,923, filed 20 October 1992)

Title: Amplified hybridization assay

Inventors: Robert J. Schneider of New York City, New York; and Thomas E. Shenk of Princeton, New Jersey.

Senior Party

Application: 08/479,995, filed 7 June 1995

Title: Assay method utilizing polynucleotide sequences

Inventors: Robert G. Pergolizzi of New Milford, New Jersey; Jannis G. Stavrianopoulos of New York City, New York; Elazar Rabbani of New York City, New York; Dean L. Engelhardt of New York City, New York; Stan Kline of Brooklyn, New York; and Paula J. Olsiewski of New York City, New York.

F. Count, claims, and accorded benefit

Count 1

A method for the detection of a target nucleotide sequence, comprising:

- (a) contacting the target nucleotide under conditions that permit hybridization with (i) a primary probe which comprises a polynucleotide sequence that is complementary to the target nucleotide sequence and a polymeric tail that has binding sites that are incapable of binding to the target sequence, and (ii) a plurality of secondary probes comprising a family of signal-generating probes each member of which comprises a signal generating component and a polymer capable of binding to a different portion of the tail of the primary probe; and

1 (b) detecting the amplified signal generated by a reaction product formed in  
2 step (a), in which the polynucleotide sequence of the primary probe is  
3 hybridized to the target nucleotide and a plurality of secondary probes are  
4 bound to different portions of the primary probe tail.

5 The claims of the parties are:

6 Princeton 269: 1-62

7 Princeton 188: 1-19

8 Enzo.: 283-362, 364, 365, 382, 383, 400, 401, 403, 404, 406, 407,  
9 409-439, 441-505, 507, 508, 510, 511, and 528-547

10 The claims corresponding to Count 1:

11 Princeton 269: 1-62

12 Princeton 188: 1-19

13 Enzo.: 283-362, 364, 365, 382, 383, 400, 401, 403, 404, 406, 407,  
14 409-439, 441-505, 507, 508, 510, 511, and 528-547<sup>4</sup>

15 The claims not corresponding to Count 1:

16 Princeton 269: None

17 Princeton 188: None

18 Enzo.: None

19 The benefit accorded for Count 1:

20 Princeton: 07/400,831, filed 29 August 1989; and

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<sup>4</sup> There is at least one multiply dependent claim that provides basis for another multiply dependent claim in violation of 35 U.S.C. 112(5).

06/808,695, filed 13 December 1985.

Enzo.: 08/342,667 filed 21 November 1994;

07/805,274, filed 10 December 1991;

07/607,787, filed 26 October 1990;

06/922,757, filed 24 October 1986; and

06/491,929, filed 5 May 1983.

G. Heading to be used on papers; exhibit numbers

Addendum 1 provides the heading that shall be used on all papers filed in the contested case. See SO ¶ 106.1.1.

The range of exhibit numbers is assigned as follows (Bd.R. 154(c)(1); SO ¶ 154.2.1):

Enzo: 1001-1999.

Princeton: 2001-2999.

H. Order form for requesting file copies

When requesting copies of files, use of Addendum 2 (SO Form 4) will greatly expedite processing of the request. Please attach a copy of Parts E and F of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.

Attachment: Copy of the application claims for 08/479,995

Enclosure: Copy of STANDING ORDER (Paper 2)

cc (via overnight delivery):

Robert DeBerardine, ABBOTT LABORATORIES, of Abbott Park, Illinois, for the Trustees of Princeton University.

Ronald C. Fedus, ENZO BIOCHEM, INC., of New York City, New York, for Enzo Biochem, Inc.



**ADDENDUM 1**

Filed on behalf of: [Name of Party]  
By: [Name of lead counsel  
Name of backup counsel  
Street address  
City, State, and ZIP Code  
Tel:  
Fax: ]

Paper No. [Leave blank]

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

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Patent Interference No. 105,486 (RT)

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The Trustees of  
PRINCETON UNIVERSITY  
(4,882,269 and 5,424,188),  
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TITLE OF PAPER

**ADDENDUM 2****FILE COPY REQUEST**  
Patent Interference No. 105,486

Attach a copy of sections E and F of this DECLARATION to this REQUEST. On the copy, circle each patent and application that you are requesting. Include the following information to facilitate processing of this REQUEST:

1. Charge fees to USPTO Deposit Account No. \_\_\_\_\_
2. Complete address,<sup>5</sup> including street, city, state, ZIP code, and telephone number:  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_
3. Telephone, including area code: \_\_\_\_\_

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<sup>5</sup> Provide a street address, NOT a Post Office Box. The Office of Public Records uses a commercial overnight delivery service rather than the United States Postal Service to deliver file copies.